UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/942,978	08/31/2001	Ken Kutaragi	100809-16279 (SCEW 18.968	7677

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KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585	VAN HANDEL, MICHAEL P	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

PTOL-90A (Rev. 04/07)

	Application No.	Applicant(s)
Office Action Summary	09/942,978	KUTARAGI ET AL.
	Examiner	Art Unit	
	Michael Van Handel	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>24 September 2007</u>.
2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-9 and 11</u> is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) <u>1-9 and 11</u> is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☒ All   b)☐ Some * c)☐ None of:
      1.☒ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.
4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

Response to Amendment

1.   This action is responsive to an Amendment filed 9/24/2007. Claims **1-9** and **11** are

pending. Claims **1, 2, 4, 6, 7, 9,** and **11** are amended. Claims **10** and **12** are canceled.

Response to Arguments

1.   Applicant's arguments regarding claims **1, 2, 4, 6, 7, 9,** and **11**, filed 9/24/2007, have been

fully considered, but they are not persuasive.

Regarding claims **1, 2, 4, 6, 7, 9,** and **11,** the applicant argues that Stefik et al. does not

disclose providing functionality to a user terminal to monitor, and store, a contents utilizing

history at the user terminal and further does not disclose a contents utilizing history being stored

permanently as long as the contents is utilized. The applicant specifically argues that Stefik et al.

merely defines usage rights of the digital works they are attached to, and, therefore, do not

themselves provide functionality to a user terminal to monitor and store usage history at the user

terminal. The examiner respectfully disagrees.

Stefik et al. discloses a fee accounting mechanism for reporting fees associated with the

distribution and use of digital works. Usage rights and fees are attached to digital works. The

usage rights define how the digital work may be used or further distributed. The digital works

and their usage rights and fees are stored in repositories. The repositories control access to the

digital works. Upon determination that the exercise of a usage right requires a fee, the repository

generates a fee reporting transaction. Fee reporting is done to a credit server. The credit server

collects the fee information and periodically transmits it to a billing clearinghouse (see Abstract).

Stefik et al. further discloses that the credit server is a card-sized system with a memory,

a processing means, a clock, and interface means for coupling to a repository and a financial

institution (col. 18, l. 24-26, 32-36). The credit server stores fee transactions and periodically

communicates via a network with a billing clearinghouse for reconciliation (col. 18, l. 15-19).

Stefik et al. still further discloses attaching metering rights to a digital work (col. 10, l.

58-64; col. 22, l. 51-56; col. 23, l. 13-26; col. 25, l. 35-38; & col. 26, l. 61-65). The credit server

clock is used for metering usage fees (col. 14, 40-42). A Begin-charges transaction assigns a

charge for metered use. An End-charges transaction ends a charge for metered use. A report-

charges transaction between a personal credit server and a billing clearinghouse is invoked at

least once per billing period, and is used to pass along information about charges (col. 31, l. 26-

40). Stefik et al. also discloses that all billing transactions are given a transaction ID (col. 31, l.

43). Since metering usage rights attached to a digital work cause the metering and clock

functions to occur in the credit server, the examiner interprets this as "digital information itself

providing functionality to said user terminal to autonomously monitor, and store, a contents

utilizing history at the user terminal, and transmit the stored contents utilizing history along with

identification information to said information gathering means at a predetermined timing," as

currently claimed. Since the digital work state information keeps track of the remaining time of

use on a metered right (col. 10, l. 58-64), the examiner interprets this as "the contents utilizing

history is stored permanently as long as the contents is utilized," as currently claimed.

Claim Rejections - 35 USC § 101

1.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2.   Claims **9** and **11** are rejected under 35 U.S.C. 101, because the claimed invention is directed to non-statutory subject matter.

Referring to claims **9** and **11**, the claims are directed to a computer program. The examiner notes that computer programs constitute functional descriptive material; however, functional descriptive material is nonstatutory when claimed as descriptive material *per se*. The examiner recommends that the preambles of the claims be amended to recite something like "A computer-readable medium encoded with a computer program, that when executed ..." See **MPEP 2106.01** for guidance.

Claim Rejections - 35 USC § 112

1.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2.   Claims **9** and **11** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Referring to claims **9** and **11**, the examiner notes that the claims are vague and indefinite, because the scope of the claims is unclear. The preambles of the claims appear to be directed to a program *per se*, but the limitations appear to be directed toward a particular structure. The

claims recite "means-for" language, but do not appear to have any corresponding structure within

the specification. Therefore, the examiner is unable to ascertain the scope of the structures

defined by the "means-for" language.

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2.   Claims **1, 6, 9** are rejected under 35 U.S.C. 102(b) as being anticipated by Stefik et al.

Referring to claims **1, 6**, and **9**, Stefik et al. discloses a method/system/computer program

for managing fees of contents in which the fees arise based on a predetermined charging rule

upon distributing the contents (col. 4, l. 4-10), said method/system/computer program

comprising the steps of:

- equipping information gathering means on a network (Billing Clearinghouse) with

  which a user terminal (computer system) is allowed to connect (col. 7, l. 5-37), said

  user terminal carrying out information processing by utilizing said contents (col. 7, l.

  66-67; col. 8, l. 1-18, 57-67; col. 9, l. 1-5; & Figs. 3, 4b);

- embedding digital information to said contents (col. 7, l. 7-10; col. 10, l. 8-11; & col.

  11, l. 44-52), said digital information itself providing functionality to said user

  terminal to autonomously monitor, and store, a contents utilizing history at the user

  terminal (col. 22, l. 51-56; col. 23, l. 13-26; col. 25, l. 35-38; col. 26, l. 61-65; col. 31,

l. 26-40; col. 33, l. 53-57; & col. 50, l. 26-28), and transmit the stored contents

utilizing history along with identification information (col. 31, l. 16-18, 37-41) to said

information gathering means at a predetermined timing while said user terminal is

connected with said network (col. 8, l. 10-20, 57-67; col. 9, l. 1-5; col. 18, l. 12-45; &

Fig. 3);

- distributing said contents with said digital information being embedded through a

predetermined distribution mechanism (col. 4, l. 4-8; col. 10, l. 8-11; col. 11, l. 31-56;

col. 22, l. 20-27; col. 45, l. 20-67; col. 46, l. 1-67; col. 47, l. 1-67; & col. 48, l. 1-45);

- holding, by predetermined identification information holding means, identification

information for identifying said distributed contents and said distribution mechanism

(col. 8, l. 4-9; col. 10, l. 24-34, 45-67; col. 11, l. 1-13; col. 17, l. 48-67; & col. 18, l. 1-

45);

- counting a distribution condition of contents per distribution mechanism based on

said contents distributing history gathered through said information gathering means

and said identification information held by said identification information holding

means (col. 10, l. 8-11, 24-34, 45-67; col. 11, l. 1-13; col. 47, l. 30-45; & Fig. 14);

and

- determining a charging amount per distribution mechanism based on said counted

distribution condition and a charging rule for said contents (col. 17, l. 48-60; col. 18,

l. 1-45, 60-65; col. 32, l. 66-67; col. 33, l. 1-9; & col. 47, l. 30-45),

- wherein the contents utilizing history is stored permanently as long as the contents is

utilized (col. 10, l. 58-65; col. 14, l. 40-44; & col. 33, l. 53-57).

Claim Rejections - 35 USC § 103

1.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all .

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2.   Claims **2-5**, **7**, **8**, and **11** are rejected under 35 U.S.C. 103(a) as being unpatentable over

Stefik et al. in view of Aras et al.

Referring to claims **2**, **4**, **7**, and **11**, Stefik et al. discloses a method/system/computer

program for managing fees of contents in which the fees arise based on a predetermined charging

rule upon utilizing the contents, said method comprising the steps of:

-   issuing a recording medium to a user operating a user terminal which carries out

    information processing by utilizing said contents (col. 17, l. 31-36 & col. 18, l. 24-

    38), said recording medium having a data recording area in which user identification

    data is recorded (col. 13, l. 51-54, 59-67) and a memory area (col. 14, l. 28-39);

-   equipping information gathering means on a network with which said user terminal

    with said recording medium being loaded is allowed to connect (col. 7, l. 5-37);

-   embedding digital information to said contents, said digital information itself

    providing functionality to said user terminal to autonomously monitor, and store to

    said memory area, a contents utilizing history indicating utilizing condition of the

    contents at the user terminal (col. 22, l. 51-56; col. 23, l. 13-26; col. 25, l. 35-38; col.

    26, l. 61-65; col. 31, l. 26-40; col. 33, l. 53-57; & col. 50, l. 26-28), and read said

stored contents utilizing history so as to transmit said contents utilizing history to said

information gathering means along with said user identification data at a

predetermined timing while said user terminal is connected with said network (col. 8,

l. 4-9, 10-20, 57-67; col. 9, l. 1-5; col. 10, l. 24-34, 45-67; col. 11, l. 1-13; col. 17, l.

48-67; col. 18, l. 1-45; & Fig. 3);

- distributing said contents with said digital information being embedded through a

predetermined distribution mechanism (col. 4, l. 4-8; col. 10, l. 8-11; col. 11, l. 31-56;

col. 22, l. 20-27; col. 45, l. 20-67; col. 46, l. 1-67; col. 47, l. 1-67; & col. 48, l. 1-45);

- holding, by predetermined identification information holding means, identification

information for identifying said distributed contents and said distribution mechanism

(col. 8, l. 4-9; col. 10, l. 24-34, 45-67; col. 11, l. 1-13; col. 17, l. 48-67; & col. 18, l. 1-

45);

- counting a utilization condition of the contents per user based on the contents

utilizing history and the user identification data gathered through said information

gathering means (col. 10, l. 8-11, 24-34, 45-67; col. 11, l. 1-13; col. 47, l. 30-45; &

Fig. 14); and

- determining a charging amount per user based on said counted utilization condition

and a charging rule for said contents (col. 17, l. 48-60; col. 18, l. 1-45, 60-65; col. 32,

l. 66-67; col. 33, l. 1-9; & col. 47, l. 30-45),

- wherein the contents utilizing history is stored permanently as long as the contents is

utilized (col. 10, l. 58-65; col. 14, l. 40-44; & col. 33, l. 53-57).

Stefik et al. does not specifically disclose that the memory area of the data recording area be a nonvolatile memory area. Aras et al. discloses a method and apparatus for monitoring audio-visual materials presented to a subscriber (col. 6, l. 32-52). Monitored audio-visual information is stored in a Behavior Collection Table (BCT)(col. 9, l. 2-11). The BCT table is stored to a non-volatile memory, such as a flash memory (col. 16, l. 46-49). The collected information is then sent to a Behavior Collection Center (BCC) for processing (col. 12, l. 40-54). It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify the memory of Stefik et al. to be a non-volatile memory, such as that taught by Aras et al. in order to retain data in a power off event (col. 16, l. 34-49).

Referring to claims **3** and **5**, the combination of Stefik et al. and Aras et al. teaches a method for managing fees of contents according to claims 2 and 4, respectively, further comprising the steps of encrypting the contents to be distributed and issuing key information for decrypting said encrypted contents, said key information being recorded in said recording medium (Stefik et al. col. 28, l. 1-37).

Referring to claim **8**, the combination of Stefik et al. and Aras et al. teaches a system for managing fees of contents according to claim 7, wherein said recording medium is a card equipped with an IC chip (col. 14, l. 7-50 & col. 17, l. 32-36), said card being individualized per user (col. 13, l. 51-67), and information indispensable for utilizing said contents is recorded in said card (col. 28, l. 28-30).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time

policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period

will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing

date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Michael Van Handel whose telephone number is 571-272-5968.

The examiner can normally be reached on 8:00am-5:30pm Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Chris Kelley can be reached on 571-272-7331. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would

like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MVH

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